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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/638,554

08/12/2003

Teresa S. Healy

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09/28/2006

COOLEY GODWARD LLP
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EXAMINER

MORAN, KATHERINE M

ART UNIT

PAPER NUMBER

3765

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/638,554	Applicant(s) HEALY ET AL. C.	
	Examiner Katherine Moran	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 10-18, 20-28 and 30-33 is/are rejected.
- 7) ☒ Claim(s) 6, 9, 19 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/21/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's amendment of 3/24/06 has been received and reviewed. Applicant amended claims 1, 11, and 28 and also submitted new drawing sheets. The finality of the last office action is withdrawn in view of Applicant's arguments with regard to the merits of the claim rejections.

Drawings

1. The drawings were received on 3/24/06. These drawings are acceptable.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 7, 8, 10-18, 20-28, and 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamasaki et al. (Yamasaki U.S. 6,580,800). Yamasaki discloses the invention as claimed. Yamasaki teaches an ear warmer comprising a cover 1 having an outer member or surface 1a or 1 b and an inner member or surface 1a or 1b defining an interior region therebetween, a frame having a first ear portion and second ear portion at either end of a band 5 extending therebetween behind a wearer's head, and at least a portion 11 of the frame being disposed in the interior region defined by

the outer and inner members, and further including a first membrane 2 coupled to the cover, the membrane and inner member forming a first receptacle configured to receive at least a portion of an ear of the user between the membrane and cover. The membrane 2 has a movable portion 2a and a fixed portion 1d fixedly coupled to at least one of the cover member and frame, the membrane has a deployed configuration and a retracted configuration since movable portion 2a is pivotable at pivot 3. The movable portion 2a is disposed adjacent the inner member when the membrane is in its deployed configuration and at least a portion of the membrane's movable portion is disposed adjacent the outer member when the membrane is in its retracted configuration. The cover has a first ear portion, second ear portion, and middle portion extending between the first and second ear portions, and the membrane 2 is coupled to a portion of one of the first ear portion and second ear portion. The cover has an ear portion with a perimeter, the membrane is coupled to the ear portion along a perimeter of the ear portion, the portion of the perimeter is less than the entire perimeter of the ear portion as shown in Figures 1 and 2. The membrane is coupled to the outer or inner cover member. The frame and membrane collectively secure the ear warmer to a head of the user. The ear warmer includes a second cover member 1 on an opposing end of the band 5, the second cover member configured to cover at least a second portion of the second ear portion and a second membrane coupled to at least one of the second cover member and frame, with the second membrane and second cover member forming a second receptacle configured to receive at least a portion of another ear of the user. A compression force applied by the frame and a friction force by the membrane

collectively are configured to substantially secure the ear warmer to a head of the user. The first and second membrane portions are coupled along a portion of their perimeters by the band 5. The frame has a deployed configuration and a collapsed configuration depending on if the ear warmer device is being worn. The method steps of claims 28 and 30-33 are taught by the ear warmer device.

Response to Arguments

4. Applicant's arguments filed 7/21/06 have been fully considered but they are not persuasive. Applicant argues that Yamasaki fails to teach a membrane as defined in the specification. While the specification is referred to for claim interpretation purposes, specific properties of the membrane, such as being a "flexible member", are not imparted to the claim unless explicitly recited in the claim. Instead, the term membrane is given its most broad and reasonable interpretation. Yamasaki's membrane 2 includes flexible portions 4b,4c. With regard to the Webster's definition of the term "membrane", Yamasaki's membrane could be regarded as a thin, flexible layer or material. The purpose for which the membrane is designed for is not pertinent in a 35 USC 102(b) statutory rejection.

Allowable Subject Matter

5. Claims 6, 9, 19, and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert, may be reached at (571) 272-4983. The official and after final fax number for the organization where this application is assigned is (703) 872-9306. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kmm

September 23, 2006

A handwritten signature in black ink, appearing to read "K Moran", with a stylized flourish at the end.

Katherine Moran

Primary Examiner, AU 3765